

REMARKS

Reconsideration of this application, as presently amended, is respectfully requested. Claims 7, 8 and 18 are now pending in this application, claims 1, 2, 13 and 15-17 having been cancelled by the present Amendment. Claims 1, 2, 8, 13 and 15-18 were rejected. Claim 7 was allowed.

Applicants would like to thank the Examiner for the courtesies extended to applicants' representative during the personal interview conducted on May 16, 2006. During the course of the interview the rejection of each of the independent claims was discussed, with independent claim 1 as representative. Further, the rejection of dependent claim 8 was discussed.

In view of the cancellation of claims 1, 2, 13 and 15-17, the specifics of the discussion of these claims during the interview will not be summarized here. With respect to claim 8 (and claim 18, which recites features similar to claim 8), during the interview the Examiner did not dispute applicants' argument that **Freeman** did not disclose first and second switching sections provided on *input sides* of the first and second inversion sections, respectively. However, the Examiner asserted that this feature was not shown in the drawings or described in the specification, and requested that applicant point out where support for this feature is provided.

The discussion below details where support for the features recited in claims 8 and 18 is found in the specification and drawings. Therefore, as will be discussed in detail below, it is submitted that claims 8 and 18 patentably distinguish over the cited prior art.

Claim Rejections – 35 U.S.C. §102

Claims 1-2, 8, 13 and 15-18 were rejected under 35 U.S.C. §102(b) as being anticipated by **Freeman** (RE 34,363, previously cited).

Initially, it is submitted that the rejection of claims 1-2, 8, 13 and 15-17 is rendered moot in view of the cancellation of these claims. Therefore, the discussion below relates to claims 8 and 18.

Claims 8 and 18 have been rewritten in independent form to include the features of claims 1 and 17, respectively, from which they depend. Support for the features found in claims 8 and 18, particularly the feature of the first and second switching sections provided on *input sides* of the first and second inversion sections, respectively, is found, e.g., in Fig. 20 and the corresponding description in application specification on page 76, line 23 – page 77, line 17.

In the Office Action mailed February 22, 2006, the Examiner responds to the patentability arguments with respect to claim 8 (and claim 18) by asserting that “the pass transistors for [inverter, sic] 21, 22 **can be** placed in front without any change of function which is dynamically claimed by Freeman” [emphasis added] (see Office Action, page 7, lines 7-9).

It is respectfully submitted that the Examiner’s reasoning supporting the rejection of claims 8 and 18 is legally and technologically incorrect, and therefore the rejection under §102 is improper and should be withdrawn.

More specifically, it is well settled that anticipation under §102 is established only if all the elements of an invention, *as stated in the claim*, are *identically* set forth in a single prior art reference. Moreover, it is not sufficient that each element be found somewhere in the reference,

the elements **must be arranged as in the claim.** *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 703 F.2d 1452, 1458 (Fed. Cir. 1984).

There is no teaching or suggestion in **Freeman** of placing the pass transistors for the inverters 21, 22 at the input of the inverters. The Examiner attempts to **rearrange** the pass transistors of **Freeman** by asserting that the pass transistors “**can be**” placed in front. However, this is the Examiner’s teaching, and not the teaching of the **Freeman** reference. In the absence of any disclosure or suggestion in the **Freeman** reference that the pass transistors are placed “in front” of the inverters 21, 22 (i.e., at the input), it is submitted that the rejection of claims 8 and 18 under §102 is improper and should be withdrawn for at least this reason.

Second, contrary to the Examiner’s assertion, placing the pass transistors for inverters 21, 22 “in front” (i.e., at the input) of the inverters would clearly change the function of the **Freeman** circuit. For example, if the pass transistor /C2 is placed “in front” of inverter 21, and /C2 = 0 ($C2 = 1$), then the signal /A is **not** output from inverter 21 and passed to gate 23 (i.e., it is cut off by pass transistor /C2). However, the **Freeman** circuit, as disclosed in Fig. 2, is clearly designed such that when /C2 = 0 ($C2 = 1$), the inverted output /A is **passed** to gate 23. Therefore, the rearrangement of pass transistors as suggested by the Examiner clearly changes the function of the **Freeman** circuit.

Finally, although the current rejection is under §102 (anticipation), and not under §103 (obviousness), it is noted that the law regarding §103 addresses whether the fact that a reference **could be** modified or is **capable of** being modified to result in the claimed invention is enough to

establish obviousness under §103. As indicated above, the Examiner stated “the pass transistors for [inverter, sic] 21, 22 **can be** placed in front...”

More particularly, it is well established that although the structure in a prior art reference could be modified to form the claimed structure, “the mere fact that the prior art **could be** so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *In re Laskowski*, 871 F. 2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). Further, although a prior art device “may **be capable** of being modified to run the way [the patent applicant’s] apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990).

Therefore, it is respectfully submitted that even if the **Freeman** reference **could be** modified to result in the claimed invention, this does not support a §103 rejection unless there is a suggestion or motivation in the reference for the modification. As noted above, modifying the **Freeman** reference as suggested destroys the function of the **Freeman** reference.

Accordingly, reconsideration and withdrawal of the rejections of claims 8 and 18 under §102 are respectfully requested for at least the above reasons.

Finally, with respect to claim 8, it is noted that **Freeman** does not disclose or suggest *a transmission section (or outputting section or selector) that selects between outputting the inverted first input signal and the inverted second input signal in response to only an externally controllable selection signal and an inverted signal of the selection signal.*

In contrast to the invention recited in claim 1, **Freeman** discloses that selecting between transmitting (i.e., outputting) /A or /B to the circuitry 23, 24, 25 requires at least four (4)

configuration control signals. For example, C2, /C2 and C3, /C3 are required to select between outputting /A or /B to the OR gate 23 in **Freeman**.

Therefore, it is submitted that claim 8 is allowable for this additional reason.

CONCLUSION

In view of the foregoing amendments and accompanying remarks, it is submitted that all pending claims are in condition for allowance. A prompt and favorable reconsideration of the rejection and an indication of allowability of all pending claims are earnestly solicited.

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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